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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/281,797	03/31/1999	ATSUSHI TESHIMA	0905-0216P	7652

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EXAMINER

TRAN, PHILIP B

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 07/21/2004

27

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/281,797

Applicant(s)

TESHIMA, ATSUSHI

Examiner

Philip B Tran

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4,7,8,10 and 30-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,4,7,8,10 and 30-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>26</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the Interview Summary on 7/9/2004. In view of the Interview Summary on 7/9/2004, the finality of that action is withdrawn and prosecution is hereby reopened. New office action is set forth below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The analysis under 35 U.S.C. 112, first paragraph, requires that the scope of protection sought be supported by the specification disclosure. The pertinent inquiries include determining (1) whether the subject matter defined in the claims is described in the specification and (2) whether the specification disclosure as a whole is to enable one skilled in the art to make and use the claimed invention.

(1) Claims 30-32 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The "invention" for the purpose of the first paragraph analysis is defined by the claims. The description requirement is simply that the claimed subject matter must be described in the specification. The function of the description requirement is to ensure that the applicant had possession of the invention on the filing date of the application. The application need not describe the claim limitations exactly, but must be sufficiently

clear for one of ordinary skill in the art to recognize that the applicant's invention encompasses the recited limitations. The description requirement is not met if the application does not expressly or inherently disclose the claimed invention.

Specification does not explicitly describe nor is sufficiently clear for one of ordinary skill in art to recognize the following steps as recited in claims 30-32 :

. "...to **display only layout frames** in a preview area on a display area screen ...".

Claims 30-32 are unclear that the one ordinarily skilled in the art cannot recognize the encompassed claim limitations.

(2) Claims 30-32 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The enablement requirement necessitates a determination that the disclosure contains sufficient teaching regarding the subject matter claimed as to enable one skilled in the pertinent art to make and use the claimed invention. In essence, the scope of enablement provided to one ordinarily skilled in the art by the disclosure must be commensurate with the scope of protection sought by the claims.

Currently, the most prevalent standard for measuring sufficient enablement to meet the requirements of 112 is that of "undue experimentation". The test is whether, at the time of the invention, there was sufficient working procedure for one skilled in the art to practice the claimed invention without undue experimentation. It is important to note

that the test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, is it undue. An skilled artisan is given sufficient direction or guidance in the disclosure. Moreover, the experimentation required, in addition to not being undue, must not require ingenuity beyond that expect of one of ordinary skill in the art.

Undue experimentation and ingenuity would be required beyond one ordinarily skilled in the art to practice the following steps as recited in claims 30-32 :

. “...to **display only layout frames** in a preview area on a display area screen
...”.

Undue experimentation would be needed to display only layout frames in a preview area on a display area screen without displaying characters within those layout frames.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 2, 4, 7, 8, 10 and 30-32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Flowers, Jr. et al (Hereafter, Flowers), U.S. Pat. No. 5,533,174 in view of Shimizu, U.S. Pat. No. 6,189,020.

Regarding claim 30, Flowers teaches a font sharing system in which data can be communicated between a client computer and a server (i.e., work station 12 and font server 16), data representing a character string including a plurality of characters and data representing sizes of characters are included in the character string being transmitted to the server from the client computer (i.e., the client supplies information such as font name or printing or display features such as desired letter height, orientation, writing mode, and so forth to the server) [see Abstract and Col. 2, Line 50 - Col. 3, Line 16], the server comprising :

layout generating means for generating data representing a layout based upon the data representing the character string and the data representing the sizes of characters transmitted from the client computer (i.e., the font server receives information supplied by the client regarding font name or printing or display features such as desired letter height, orientation, writing mode, and so forth and retrieves an appropriate font from storage and prepare the font for use with the current application

and then customizing the font as necessary and rendering outlines and/or bit maps and reformatting the bit maps or outlines) [see Abstract and Col. 2, Line 50 - Col. 3, Line 16 and Col. 3, Lines 17-30 and Col. 4, Lines 30-34 and Col. 4, Lines 50-67 and Col. 6, Lines 10-16]; and

transmitting means for transmitting the layout data generated by the layout generating means (i.e., the font server supplies the outlines and /or bit maps to the client in a format which is compatible with the client's application software) [see Col. 4, Lines 34-36 and Col. 6, Lines 24-29];

the client computer comprising :

display control means for controlling a display device so as to display frames on a display screen, each of the frames corresponding to the size of each character included in the character string based upon the layout data transmitted from the transmitting means of the server (i.e., client prints or displays characters with shapes according to bitmap or outlines wherein the outlines indicate the boundaries or frames of various characters) [see Fig. 3B and Col. 2, Lines 32-33 and Col. 6, Lines 6-23 and Col. 9, Lines 62-65].

Flowers does not explicitly teach displaying in a preview area each of the frames are box-shaped such that each of the frames is able to enclose their respective characters that are represented by the data representing the sizes of characters. However, Shimizu in the same field of type-setting character font endeavor, discloses box-shaped frames for enclosing character string specifying fonts [see Shimizu, Abstract and Fig. 6 and Col. 3, Lines 30-53, Col. 7, Lines 15-22, Col. 11, Lines 10-12

and Col. 12, Lines 30-41]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the use a box-shaped frame, disclosed by Shimizu, into a font sharing system in which data can be communicated between a client computer and a server disclosed by Flowers, in order to layout character string within a designated configuration regions specifying the appearance shape of the proportional spacing fonts of the desirable character string can be outputted and displayed in a preview area.

Regarding claim 2, Flowers further teaches the server retrieves, from a first character image data storage means, character image data expressing a character, which has been specified by the character string and has a size that has been designated by size designating data, as an image in such a manner that the specified character will have a font specified by font specifying data (i.e., the font server retrieves an appropriate font from storage and prepare the font for use with the current application and produces bit maps or outlines, as appropriate, in accordance with specified rendering instruction) [see Col. 3, Lines 17-30 and Col. 4, Lines 30-34 and Col. 11, Lines 30-32].

Regarding claim 4, Flowers further teaches second character image data storage means for storing character image data expressing a character as an image (i.e., font storage 18) [see Figs. 1-2];

determination means for determining whether character image data expressing a character as an image has been stored in the second character image data storage means, wherein the character has been specified by the character string, has a font that has been specified by the font specifying data and a size that has been designated by the size designating data (i.e., determining if selected font exists in the font storage) [see Col. 5, Lines 6-16]; and

enlarging/reducing means which, in response to a determination by said determination means to the effect that the character image data has not been stored in the second character image data storage means, is for processing the character image data in such a manner that, of character image data that has been stored in the second character image data storage means, a character image that has been specified by the character specifying data and has a font that has been specified by the font specifying data will be enlarged or reduced so as to take on a size that has been designated by the size designating data (i.e., customizing font by enlarging or eliminating glyph and scaling the glyph shape to a desired size) [see Col. 7, Lines 30-65].

Regarding claim 7, Flowers further teaches the client includes style data transmitting means for transmitting, to the server, character style designating data for designating style of a character specified by the character specifying data (i.e., the client supplies requested information such as font or character style display feature) [see Col. 1, Lines 13-60 and Col. 2, Line 62 - Col. 3, Line 30]; and

the server further includes:

designated character-style retrieval means for retrieving, from a first character image data storage means, designated-style character image data expressing, as an image, a character of a style designated by the character style designating data transmitted from the style data transmitting means (i.e., the font server retrieves an appropriate font from storage and prepare the font for use with the current application) [see Col. 3, Lines 17-30];

designated-style character image data generating means for generating the designated-style character image data in response to a situation where the designated-style character image data is not found by the designated character-style retrieval means (i.e., customizing the font as necessary and rendering outlines and/or bit maps and reformatting the bit maps or outlines) [see Col. 4, Lines 30-34 and Col. 6, Lines 10-16]; and

designated-style character image data transmitting means for transmitting, to the client computer, the designated-style character image data generated by the designated-style character image data generating means or the designated-style character image data found by the designated character-style retrieval means (i.e., the font server supplies the outlines and /or bit maps to the client in a format which is compatible with the client's application software) [see Col. 4, Lines 34-36 and Col. 6, Lines 24-29].

Regarding claim 8, Flowers further teaches the server includes style information transmitting means for transmitting, to the client computer, style information for

generating the designated-style character image data (i.e., the font server provides a user a list of the catalogues, a list of font families, and so forth to allow the user to select a desired font) [see Col. 3, Lines 17-30 and Col. 8, Lines 35-53]; and

the client computer includes means for generating the designated-style character image data based upon the style information and the character image data transmitted from the style information transmitting means (i.e., client follows the procedures to customize the font, as appropriate, and acquire character metrics and bit maps or outlines needed for printing and display) [see Col. 9, Lines 30-65].

Regarding claim 10, Flowers further teaches the server includes a printing device (i.e., associated printers 14) [see Figs 1-2], and means for generating new character image data, from the character image data that has been designated by the character image data generating means, so as to obtain a character image having a resolution suited to the resolution of the printing device (i.e., selecting appropriate font and customizing the font as necessary and supplying the outlines and/or bit maps to the client in a format which is compatible with client) [see Col. 4, Lines 28-46 and Col. 5, Lines 25-61].

Regarding claim 31, Flowers teaches a client computer capable of communicating data with a server comprising :

input means for inputting a character string including a plurality of characters (i.e., the client or the user at the client requests font lists, then checks and selects a font

from the list) [see Abstract, Col. 3, Lines 17-30 and Col. 4, Line 50 - Col. 5, Line 16 and Col. 8, Lines 54-65 and Col. 9, Line 30 - Col. 10, Line 12 and Col. 12, Lines 13-21]; designating means for designating sizes of characters included in the character string inputted from the input means (i.e., customizing the font as necessary and rendering outlines and/or bit maps and reformatting the bit maps or outlines) [see Col. 4, Lines 30-34 and Col. 6, Lines 10-16];

transmitting means for transmitting the character string data inputted from the input means and data representing the sizes of characters designated by the designating means (i.e., the font server supplies the outlines and /or bit maps to the client in a format which is compatible with the client's application software) [see Col. 4, Lines 34-36 and Col. 6, Lines 24-29];

layout data receiving means for receiving layout data generated by the server based upon the data representing the character string and the data representing the sizes of characters transmitted from the transmitting means (i.e., client obtains character shapes or characters metrics) [see Col. 11, Line 62 - Col. 12, Line 2]; and

display control means for controlling a display device so as to display frame on a display screen, each of the frame corresponding to the size of each character included in the character string based upon the layout data received from the receiving means of the server (i.e., client prints or displays characters with shapes according to bitmap or outlines wherein the outlines indicate the boundaries or frames of various characters) [see Fig. 3B and Col. 2, Lines 32-33 and Col. 6, Lines 6-23 and Col. 9, Lines 62-65].

Flowers does not explicitly teach displaying in a preview area each of the frames are box-shaped such that each of the frames is able to enclose their respective characters that are represented by the data representing the sizes of characters. However, Shimizu in the same field of type-setting character font endeavor, discloses box-shaped frames for enclosing character string specifying fonts [see Shimizu, Abstract and Fig. 6 and Col. 3, Lines 30-53, Col. 7, Lines 15-22, Col. 11, Lines 10-12 and Col. 12, Lines 30-41]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the use a box-shaped frame, disclosed by Shimizu, into a font sharing system in which data can be communicated between a client computer and a server disclosed by Flowers, in order to layout character string within a designated configuration regions specifying the appearance shape of the proportional spacing fonts of the desirable character string can be outputted and displayed in a preview area.

Regarding claim 32, Flowers teaches a server capable of communicating data with a client computer comprising :

receiving means for receiving data representing a character string including a plurality of characters transmitted from the client computer and sizes of characters, which are included in the character string transmitted from the client computer (i.e., the font server receives information supplied by the client regarding font name or printing or display features such as desired letter height, orientation, writing mode, and so forth) [see Abstract and Col. 2, Line 50 - Col. 3, Line 16];

layout generating means for generating data representing a layout based upon the data representing the character string and the data representing the sizes of characters (i.e., the font server retrieves an appropriate font from storage and prepare the font for use with the current application and then customizing the font as necessary and rendering outlines and/or bit maps and reformatting the bit maps or outlines) [see Abstract and Col. 2, Line 50 - Col. 3, Line 16 and Col. 3, Lines 17-30 and Col. 4, Lines 30-34 and Col. 4, Lines 50-67 and Col. 6, Lines 10-16]; and

transmitting means for transmitting the layout data generated by the layout generating means (i.e., the font server supplies the outlines and /or bit maps to the client in a format which is compatible with the client's application software) [see Col. 4, Lines 34-36 and Col. 6, Lines 24-29].

Flowers does not explicitly teach displaying in a preview area each of the frames are box-shaped such that each of the frames is able to enclose their respective characters that are represented by the data representing the sizes of characters. However, Shimizu in the same field of type-setting character font endeavor, discloses box-shaped frames for enclosing character string specifying fonts [see Shimizu, Abstract and Fig. 6 and Col. 3, Lines 30-53, Col. 7, Lines 15-22, Col. 11, Lines 10-12 and Col. 12, Lines 30-41]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the use a box-shaped frame, disclosed by Shimizu, into a font sharing system in which data can be communicated between a client computer and a server disclosed by Flowers, in order to layout character string within a designated configuration regions specifying the appearance

shape of the proportional spacing fonts of the desirable character string can be outputted and displayed in a preview area.

5. A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE THREE MONTHS, OR THIRTY DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION. FAILURE TO RESPOND WITHIN THE PERIOD FOR RESPONSE WILL CAUSE THE APPLICATION TO BECOME ABANDONED (35 U.S.C. § 133). EXTENSIONS OF TIME MAY BE OBTAINED UNDER THE PROVISIONS OF 37 CAR 1.136(A).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (703) 308-8767. The Group fax phone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam, can be reached on (703) 308-6662.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Philip Tran

Philip B. Tran
Art Unit 2155
July 15, 2004